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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/031,162

05/20/2002

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PAA-102-A

4990

7590

08/15/2006

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EXAMINER

THALER, MICHAEL H

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,162

Applicant(s)

LYAPKO, NIKOLAI
GRIGORIEVICH

Examiner

Michael Thaler

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 21, 2006 has been entered.

Claims 14-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original disclosure for the limitation in claim 14, lines 5-8 that the invention includes two sets of needles in which both sets include needles partially covered with a coating. The specification, on page 11, lines 6-26 lists only needles 25, 27 and 32 as being partially coated. However, these three needles do not comprise two sets of needles since a set, by definition includes at least two items. Further, there is no basis in the original disclosure for the limitations in claims 15 and 18-21.

Claims 14-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 14, lines 10-12, the phrase "to expose a surface of contact between each needle and a user's epidermis to at least said first and second materials having said different electrochemical potentials" is unclear. Although the phrase "to expose a surface of contact between each needle and a user's epidermis" is clear, the phrase "to at least said first and second materials having said different electrochemical potentials" is unclear in that it is unclear how this relates to the first, clear phrase. In claim 16, line 1, for example, it is unclear if "the coating" refers to the coating defined in claim 14, line 5 or the coating defined in claim 14, lines 6-8.

Claims 14-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (5,676,684) in view of Gabrusenok (SU 1264942). Choi discloses base member 15 and needles (col. 5, line 14) fixed therein, each of the needles comprising a rod, a sharpened portion and a head (the portion of the needle adjacent to base member 15). Choi fails to disclose the needles as being partially coated with a coating. However, Gabrusenok teaches that acupuncture needles should be partially coated with a coating in order to obtain the advantage of creating

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electrochemical potentials (abstract). It would have been obvious to partially coat the Choi needles with a coating so that it too would have this advantage. With this modification, the Choi needles would include a first set of needles (e.g. the needles on the left half of the device) being made from a first material (i.e. the material of the needle itself which is labeled 1 in Gabrusenok) and a second set of needles (e.g. the needles on the right half of the device) being coated a second material (i.e. the material of the coating labeled 3 in Gabrusenok), the first and second materials having different electrochemical potential (as indicated in the Gabrusenok abstract), the needles being only partially covered with a coating (as seen in the Gabrusenok drawing) to expose a surface of contact between each needle and a use's epidermis. As indicated above, the phrase "to at least said first and second materials having said different electrochemical potentials" is unclear and is not understood. As to claims 22 and 23, Choi fails to disclose the claimed materials for the needle and/ or coatings. However, applicant admits that these materials are old and well known in an applicator comprising a base member and needles (page 1, line 31 to page 2, line 2 of applicant's specification) which apparently has the advantages of making the needle strong and biologically inert. It would have been

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obvious to use these materials for the Choi device so that it too would have these advantages.

Applicant's arguments filed July 21, 2006 have been fully considered but they are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

mht
8/9/06



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731